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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,517	06/29/2004	Peter Charles Astles	22059P	8378
210	7590	12/06/2006	EXAMINER	
MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907			SEAMAN, D MARGARET M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/500,517	ASTLES ET AL.	
	Examiner	Art Unit	
	D. Margaret Seaman	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,13-55 and 57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-7,13-55 and 57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This application was filed 6/29/2004 and is a 371 of PCT/US02/21297 (filed 7/29/2002), which claims benefit of 60/350150 (1/17/2002). Claims 1-7, 13-55 and 57 are before the examiner and are subject to the following lack of unity of invention.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia and E is O or S.

Group 2, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia where E is NR5.

Group 3, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia and E is C(R5)2.

Group 4, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia where E is O-C(R5)2 or C(R5)2-O.

Group 5, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia and E is N(R5)-C(R5)2 or C(R5)2-N(R5).

Group 6, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia where E is NR5-C(O) or C(O)-NR5.

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Group 7, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia and E is C(R5)₂-S(O).

Group 8, claim(s) 1-7 (in part), drawn to methods of treatment of formula Ia where E is C(R5)₂-C(R5)₂ or C(R5)=C(R5).

Group 9, claim(s) 1-7 (in part), drawn to methods of treatment of formula I and m+n=2.

Group 10, claim(s) 1-7 (in part), drawn to methods of treatment of formula I where m+n=3.

Group 11, claim(s) 1-7 (in part), drawn to methods of treatment of formula I and m+n=4

Group 12, claim(s) 1-7 (in part), drawn to methods of treatment of formula I and m+n=5.

Group 13, claim(s) 1-7 (in part), drawn to methods of treatment of formula I and m+n=6.

Group 14, claim(s) 13-55 and 57 (in part), drawn compounds of formula Ia and E is O or S.

Group 15, claim(s) 13-55 and 57 (in part), drawn to compounds of formula Ia where E is NR₅.

Group 16, claim(s) 13-55 and 57 (in part), drawn to compounds of formula Ia and E is C(R5)₂.

Group 17, claim(s) 13-55 and 57 (in part), drawn to compounds of formula Ia where E is O-C(R5)₂ or C(R5)₂-O.

Group 18, claim(s) 13-55 and 57 (in part), drawn to compounds of formula Ia and E is N(R5)-C(R5)₂ or C(R5)₂-N(R5).

Group 19, claim(s) 13-55 and 57 (in part), drawn to compounds of formula Ia where E is NR₅-C(O) or C(O)-NR₅.

Group 20, claim(s) 13-55 and 57 (in part), drawn to compounds of formula Ia and E is C(R5)₂-S(O).

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Group 21, claim(s) 13-55 and 57 (in part), drawn to compounds of formula Ia where E is $C(R5)_2-C(R5)_2$ or $C(R5)=C(R5)$.

Group 22, claim(s) 13-55 and 57 (in part), drawn to compounds of formula I and $m+n=2$.

Group 23, claim(s) 13-55 and 57 (in part), drawn to compounds of formula I where $m+n=3$.

Group 24, claim(s) 13-55 and 57 (in part), drawn to compounds of formula I and $m+n=4$.

Group 25, claim(s) 13-55 and 57 (in part), drawn to compounds of formula I and $m+n=5$.

Group 26, claim(s) 13-55 and 57 (in part), drawn to compounds of formula I and $m+n=6$.

2. The inventions listed as Groups 1-26 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the corresponding technical feature is C-S-CH. This is a well-known technical feature common in benzothiophene rings.

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 730am-4pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



D. Margaret Seaman
Primary Examiner
Art Unit 1625

dms